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EXAMINER
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ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/199,566

Applicant(s)

SAITO ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-40 have been examined.

#### ***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 10, 2004 has been entered (thus entering the After Final amendment of July 12, 2004, which was non-entered by Examiner's Advisory Action).

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: In the last line of claim 1, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claim 2 is objected to because of the following informalities: In the last line of claim 2, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claims 3-13 are objected to because of the following informalities: In the last line of claim 3, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claims 13-25 are objected to because of the following informalities: In the last line of claim 14, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claim 26 is objected to because of the following informalities: In the last line of claim 26, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claim 27 is objected to because of the following informalities: In the last line of claim 27, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claims 28-32 are objected to because of the following informalities: In the last line of claim 28, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claims 33-37 are objected to because of the following informalities: In the last line of claim 33, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claim 38 is objected to because of the following informalities: In the last line of claim 38, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

Claim 39 is objected to because of the following informalities: In the last line of claim 39, "reissuing our issuing" should be "reissuing or issuing". Also, beginning from the twelfth line of claim 39, the claim language now reads, "a control section that controls the communication unit, the image input unit, the display unit, the data input

unit, and the signature input unit, indirectly communicates with the second host computer and the third host computer through the first computer, transmits, the PIN to the first host computer through the communication unit PIN to the first host computer through the communication unit, identifies the applicant according to the PIN, and carries out a procedure for the payment from the account specified by the PIN;". The comma after "transmits" should be deleted, as should the repetition of "PIN to the first host computer through the communication unit". Appropriate correction is required.

Claim 40 is objected to because of the following informalities: In the last line of claim 40, "reissuing our issuing" should be "reissuing or issuing". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

**Claim 1**

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), "MASTERCARD: Competing Banks Collaborate during First Implementation of SET Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification document transaction apparatus connected to a residents database storing therein identification data of the residents and also connected to a center which executes an examination for issuance of identification documents through a communication line, said apparatus comprising: a communication unit for communicating with said center (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit for inputting data for the application (column 15, lines 21-40).

Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe does not expressly disclose a sign input unit for inputting a sign of the applicant, but official notice is taken that it is well known to use sign input units for inputting a sign of an applicant. (For example, Examiner inputted his signature into such a unit to have a reproduction of his signature printed on his Virginia driver's license.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include such a sign input unit, for the obvious advantage of obtaining the identification document applicant's signature for the identification document and/or for issuer's records.

Watanabe does not expressly disclose a control section for transmitting the image and the data inputted by each of the input units to the center using the communication unit, but it is held to be inherent that there must be circuitry and/or software to carry this out. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on the image and the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4); also, Watanabe does disclose checking images against the applicant, implying that the applied for document is issued or not based on the image(s) (column 15, lines 25-31). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the image and the recorded identification data and the transmitted input data, for the obvious

advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, so that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of the applicant, so that the transaction apparatus identifies a purchaser based on the result of the authentication, as taught by "Competing Banks" (especially the paragraph beginning "Mr. Roland Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.



Watanabe does not disclose that the image input unit is also used for monitoring the applicant, except in the sense that taking pictures which are then used in determining whether to reissue a document may comprise monitoring of the person photographed, but official notice is taken that it is well known to use image input units (e.g., security cameras) to monitor people. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the image input unit also be used for monitoring the passport applicant, for such obvious advantages as assisting the passport applicant in applying for a passport correctly, and assuring that the passport applicant does not steal any valuables available at the site. Furthermore, the mere recitation of an intended use does not make known apparatus patentable.

Watanabe does not disclose that said residents database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the residents database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued

passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

## **Claim 2**

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al (U.S. Patent 5,235,165), "MASTERCARD: Competing Banks Collaborate during First Implementation of SET

Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification document transaction apparatus connected through a communication line to a center which executes an examination for issuance of identification documents, as well as to a residents database which stores identification data of residents for providing services for issuing identification documents to residents, said apparatus comprising: a communication unit for communicating with said center (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit for inputting data of the application (column 15, lines 21-40). Watanabe does not expressly disclose a control unit for transmitting the image, and the data inputted by each of the input units and the identification data of the applicant fetched using the communication unit to the center using the communication unit, but it is held to be inherent that there must be circuitry and/or software to carry this out. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on the image and the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4); also, Watanabe does disclose checking images against the applicant, implying that the applied for document is issued or not based on the image(s) (column 15, lines 25-31). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document

is to be issued or not based on the image and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe does not expressly disclose a sign input unit for inputting a sign of the applicant, but official notice is taken that it is well known to use sign input units for inputting a sign of an applicant. (For example, Examiner inputted his signature into such a unit to have a reproduction of his signature printed on his Virginia driver's license.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include such a sign input unit, for the obvious advantage of obtaining the identification document applicant's signature for the identification document and/or for issuer's records.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it

would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, so that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of the applicant, so that the transaction apparatus identifies the applicant based on the result of the authentication, as taught by "Competing Banks" (especially paragraph beginning "Mr. Roland Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.

Watanabe does not disclose that the image input unit is also used for monitoring the applicant, but official notice is taken that it is well known to use image input units (e.g., security cameras) to monitor people. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the image input unit also be used for monitoring the passport applicant, for such obvious advantages as assisting the passport applicant in applying for a passport correctly, and assuring that

the passport applicant does not steal any valuables available at the site. Furthermore, the mere recitation of an intended use does not make known apparatus patentable.

Watanabe does not disclose that said residents database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the residents database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

### **Claims 3-13**

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), "MASTERCARD: Competing Banks Collaborate during First Implementation of SET Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification document apparatus which provides the data for issuance of a certificate for an applicant and executes examination for issuance of identification documents for processing identification documents through communication with the center via a communication line, said apparatus comprising: a communication unit for communicating with said center (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document

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(column 15, lines 1-31); and a data input unit for inputting data for the identification document transaction (column 15, lines 21-40). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe does not quite expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on at least the monitored image, but Watanabe does disclose checking images against the applicant, implying that the applied for document is issued or not based on the image(s) (column 15, lines 25-31). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to orchestrate the center to make this determination, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose a display unit for displaying a guidance for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.



Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to print the image, for the obvious advantage of producing a photographic identification document.

Watanabe discloses an issuer unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, so that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of a purchaser, so that the

transaction apparatus identifies the applicant based on the result of the authentication, as taught by "Competing Banks" (see especially paragraph beginning "Mr. Roland Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.

Watanabe does not disclose that the image input unit is also used for monitoring the applicant at a site from said image input unit, but official notice is taken that it is well known to use image input units (e.g., security cameras) to monitor people remotely. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the image input unit also be used for monitoring the passport applicant at a remote site, for such obvious advantages as assisting the passport applicant in applying for a passport correctly, and assuring that the passport applicant does not steal any valuables available at the remote site. Furthermore, the mere recitation of an intended use does not make known apparatus patentable.

Watanabe does not disclose that a first database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have a first database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State

Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious

advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe discloses an identification document data input unit for inputting the contents of an issued identification document as data (column 4, lines 30-35; column 12, lines 26-30); and discloses orchestrating, when reissuing an identification document, the display unit and data input unit so as to amend the data required using data inputted from the identification document data input unit (column 12, line 41, through column 13, line 54).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 4 above. Watanabe discloses that an input unit reads the image of an issued identification document, and recognizes the characters in the read image in order to input the data (column 12, lines 26-30).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe does not expressly disclose a receipt issuer unit for issuing receipt authorization data for checking an applicant when an identification document is issued to the applicant, but Sukegawa et al. teach this (column 9, lines 7-15). Neither Watanabe nor Sukegawa et al. disclose having the control unit determine whether the applied for identification document is to be issued or not by verifying the authorization in

a storing unit, but official notice is taken that it is well known to provide or not provide a product or service to a customer according to whether it can be verified that he has paid for it. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the control unit determine whether the applied for identification document is to be issued by verifying the receipt authorization, for the obvious advantage of issuing documents to, and only to, those who have paid for them.

Watanabe does not expressly disclose issuing receipt authorization data for checking an applicant when an identification document is issued on a later day, but official notice is taken that it is well known for receipts to be used to obtain goods or services on a later day (e.g., layaway plans). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to issue receipt authorization data for checking an applicant when a passport was issued to the applicant on a later day, for the obvious advantage of easing issuance, when, for a variety of reasons, a passport could not be issued at once. (Reasons might include lack of stock of passport blanks, the need to verify certain information, or summon human beings to make sensitive decisions, etc. For that matter, the present examiner has several times in his life applied for and obtained passports, and, if his recollection serves, passports were not issued until some days after he had gone to the Post Office, paid the requisite fees, submitted photographs, etc.)

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe does not expressly disclose that the image input unit is a digital camera, but does disclose that a CCD (charge-coupled device) rather than a conventional silver halide photographic system is used (column 15, lines 1-14). Official notice is taken that digital cameras are well known, particularly in association with CCD's; hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to use a digital camera, for the stated advantage of taking and storing a number of shots within a short time.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe does not disclose that the apparatus further comprises a voice outputting unit for providing guidance by voice for the transaction procedure; or that the control unit outputs messages previously prepared with voice according to the progress of the transaction procedure by controlling the voice outputting unit. However, official notice is taken that it is well known to use voice outputting units to provide guidance by voice, and to have a control unit output messages previously prepared with voice according to the progress of a procedure by controlling the voice outputting unit. (An example with which millions of people must be familiar, often to their frustration, is the kind of voicemail system in which previously prepared voice messages are outputted to the caller depending on his progress in selecting telephone buttons to press or answers

to speak.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the apparatus further comprise such a voice outputting unit for providing guidance, and to output messages previously prepared with voice according to the progress of the transaction procedure, for the obvious advantages of conveniently providing instructions to people who may be imperfectly literate, providing instructions by voice to save people the trouble of attempting to read instructions while at the same time entering data, and saving the expense of a display screen as opposed to a microphone.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe does not disclose, that the display unit is a display unit based on an integrated touch panel system, but official notice is taken that display units based on integrated touch panel systems are well known. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to employ a display unit based on an integrated touch panel system, for the obvious advantage of conveniently responding to a user's entries, and displaying appropriate instructions.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe discloses a direct payment unit for payment of a charge for identification document transaction with cash (Figure 3, elements 69 and 70; see also column 5, lines 50-56), wherein the input of bills and change is controlled by controlling

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the operations of the direct payment unit (Figure 2, elements 29 and 30; column 5, lines 50-56).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe does not disclose that the communication unit is connected to a center of a financial institution, or that the apparatus further comprises an indirect payment unit for processing a charge for passport application through communication between the communication unit and the financial institution, but official notice is taken that it is well known to provide indirect payment means for processing a charge through communication with a financial institution (e.g., ATM machines, apparatus for accepting credit and debit cards in many shops, etc.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the apparatus further comprise an indirect payment unit, with a connection to a financial institution, for the obvious advantages of enabling document applicants to apply for identification documents without the inconvenience of carrying sufficient cash, and sparing the operators of the identification document transaction apparatus the need to deal with substantial amounts of cash.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe discloses reading out data for issuing a certificate for the identification document applicant from the center with the communication unit (column



12, lines 53-61), and printing the certificate based on the read-out data using the printing unit (e.g., column 7, lines 20-54).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., "Competing Banks," and official notice as applied to claim 3 above. Watanabe discloses that a data input unit executes data input from a storage medium storing therein data required for transactions (column 12, lines 21-40).

#### **Claims 14-25**

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165) and "MASTERCARD: Competing Banks Collaborate during First Implementation of SET Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification card transaction apparatus for processing identification card transactions with a storage medium which stores the data required for issuance of identification cards and the data for identifying the applicants for the identification cards, said apparatus comprising: an image input unit for inputting an image of the applicant (column 15, lines 1-31); and a data input unit for inputting data for the application (column 15, lines 21-40). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe does not quite expressly disclose that the control unit determines whether the applied for identification document is to be issued or not based

on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4); also, Watanabe does disclose checking stored images against the applicant, implying that the applied for document is issued or not based on the image(s) (column 15, lines 25-31). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the recorded identification data and the transmitted input data and the monitoring image, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose a reader unit for reading out the data from the storage medium, but Sukegawa et al. teach this (element 42 in Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the apparatus comprise a reader unit for reading out the data from the storage medium, for the stated advantage of extracting relevant information from the storage medium.

Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a

guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to print the image, for the obvious advantage of producing a photographic identification document.

Watanabe discloses an issuer unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, so that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard

procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of the applicant, so that the transaction apparatus identifies the applicant based on the result of the authentication, as taught by "Competing Banks" (especially paragraph beginning "Mr. Roland Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.

Watanabe does not disclose that the image input unit is also used for monitoring the applicant at a site remote from the image input unit, but official notice is taken that it is well known to use image input units (e.g., security cameras) to monitor people remotely. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the image input unit also be used for monitoring the passport applicant at a remote site, for such obvious advantages as assisting the passport applicant in applying for a passport correctly, and assuring that the passport applicant does not steal any valuables available at the remote site. Furthermore, the mere recitation of an intended use does not make known apparatus patentable.

Watanabe does not disclose that a first database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent

applicant's invention to have a first database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request

certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

Claims 15 and 16 closely parallel claims 4 and 5, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

Claim 17 closely parallels claim 6, and is rejected under 35 U.S.C. 103(a) on the same grounds.

Claim 18 closely parallels claim 7, and is rejected under 35 U.S.C. 103(a) on the same grounds.

Claims 19, 20, 21, and 22 closely parallel claims 8, 9, 10, and 11, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

Claim 23 closely parallels claim 12, and is rejected under 35 U.S.C. 103(a) on the same grounds.

Claim 24 closely parallels claim 13, and is rejected under 35 U.S.C. 103(a) on the same grounds.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa, and "Competing Banks" as applied to claim 14 above. Watanabe discloses that data is read from an IC card (column 5, lines 57-65).

#### **Claim 26**

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165),

and "MASTERCARD: Competing Banks Collaborate during First Implementation of SET Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification document transaction method applicable to a system in which a system is connected via communication line to a center for providing data for issuance of a certificate to an applicant and executing examination for issuance of an identification document for processing identification card transactions via communication with the center, said method comprising: inputting data for checking an applicant (column 12, lines 21-40); inputting, when it is determined that the applied for identification document is to be issued, an image of the applicant (column 15, lines 1-31); and printing the image of the applicant and the contents of a description onto paper previously prepared, and issuing the identification document thus obtained by printing (column 2, lines 49-63). Watanabe does not expressly and unambiguously disclose accessing the center and determining whether the applied for identification document is to be issued or not by using data inputted for checking on an applicant, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4); also, Watanabe does disclose checking images against the applicant, implying that the applied for document is issued or not based on the image(s), and therefore on monitoring of the applicant (column 15, lines 25-31. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued according to the data inputted and monitoring of the identification

document applicant, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, so that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of the applicant, so that the transaction apparatus identifies the applicant based on the result of the authentication, as taught by "Competing Banks" (especially paragraph beginning "Mr. Roland Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.



Watanabe does not expressly disclose monitoring an applicant at said center, but official notice is taken that it is well known to monitor people, and in particular to monitor people remotely. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to monitor a passport applicant at said center, for such obvious advantages as obtaining images of the passport applicant for use in determining whether the applicant qualifies for a passport, assisting the passport applicant in applying for a passport correctly, and assuring that the passport applicant does not steal any valuables available at the remote site.

Watanabe does not disclose that a first database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the first database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at

the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

#### **Claim 27**

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), "MASTERCARD: Competing Banks Collaborate during First Implementation of SET Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification document transaction method applicable for processing

identification document transactions with a storage medium storing therein data required for issuance of identification documents as well as data for identifying applications for passports comprising: reading out of data required for issuance of an identification document from the storage medium and data for identifying an applicant (column 12, lines 21-40); inputting, when it is determined that the applied for identification document is to be issued, an image of the applicant (column 15, lines 1-31); and printing the inputted image of the applicant and the contents of a description of the applicant onto paper previously prepared, and issuing the printed identification document (column 2, lines 49-63). Watanabe discloses checking images against the applicant, implying that the applied for document is issued or not based on the image(s), and therefore on monitoring of the applicant (column 15, lines 25-31). Watanabe does not expressly and unambiguously disclose determining whether the applied for identification document is to be issued or not by using data inputted for checking on an applicant, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued according to the data read out and monitoring of the identification document applicant, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a

driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, and that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of the applicant, and that the transaction apparatus identifies the applicant based on the result of the authentication, as taught by "Competing Banks" (see especially paragraph beginning "Mr. Roland Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.

Watanabe does not expressly disclose monitoring an applicant, but official notice is taken that it is well known to monitor people. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to monitor a passport applicant, for such obvious advantages as assisting the passport applicant in

applying for a passport correctly, and assuring that the passport applicant does not steal any valuables available at the remote site.

Watanabe does not disclose that said first database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the first database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

#### **Claims 28-32**

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), Bradley et al. (U.S. Patent 5,771,071), "MASTERCARD: Competing Banks Collaborate during First Implementation of SET Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification document transaction system comprising: a center for executing examination for issuance of identification documents (Figure 2). Watanabe discloses that the center is connected to a first database storing therein data for issuing certificates to applicants (column 12, lines 31-61). Watanabe does not disclose registering data for issuance of identification documents in a second database, but Bradley et al. teach this (column 1, lines 60-66). Furthermore, the

duplication of known parts for a multiple effect is held to be obvious to one of ordinary skill in the relevant art [*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F.2d 833 (7th Cir 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)], from which the use of two databases is held to be obvious. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to connect the center accessibly to first and second databases, for the obvious advantages of enabling the system to access data useful in determining whether to issue an identification document or not, and enabling the system to make records of identification document issuance data, so it will be possible to know how many identification documents have been issued, to whom they have been issued, and to obtain information about the persons to who they have been issued.

Watanabe discloses at least one passport transaction apparatus connected via a communication line to said center for processing identification document transactions by communicating with said center, wherein said identification document transaction apparatus comprises a communication unit for communicating with said center (column 12, lines 31-33); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe does not expressly disclose a control section for controlling the input, display, and communications of each of the units to the

center using the communication unit, but it is held to be inherent that there must be circuitry and/or software to carry this out. Watanabe does not expressly disclose making the center determine whether the applied for identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and in the transmitted data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4); also, Watanabe does disclose checking images against the applicant, implying that the applied for document is issued or not based on the image(s) (column 15, lines 25-31. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the image and the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image



inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to print the image, for the obvious advantage of producing a photographic identification document.

Watanabe discloses an issuer unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, so that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of the applicant, so that the transaction apparatus identifies the applicant based on the result of the authentication, as taught by "Competing Banks" (see especially paragraph beginning "Mr. Roland

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Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.

Watanabe does not disclose that the image input unit is [also] for monitoring applicants, but official notice is taken that it is well known to use image input units (e.g., security cameras) to monitor people remotely. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the image input unit also be for monitoring passport applicants, for such obvious advantages as assisting the passport applicants in applying for a passport correctly, and assuring that the passport applicants do not steal any valuables available at the site. Furthermore, the mere recitation of an intended use does not make known apparatus patentable.

Watanabe does not disclose that said first database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the first database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., Bradley et al., "Competing Banks," and official notice as applied to claim 28 above. Watanabe discloses transmitting images to a file server, and storing them therein (column 15, lines 20-35; see also column 4, lines 36-42); thus the image input unit and communication unit are connected to each other, and the control unit transfers the image inputted by the image input unit via the communication unit to the center.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., Bradley et al., "Competing Banks," and official notice as applied to claim 28 above. Watanabe does not expressly disclose a voice inputting unit and voice outputting unit, nor does Watanabe disclose that the communication unit transfers the voice inputted with the voice input unit to the center and also outputs the voice transferred from the center to the voice outputting unit. However, official notice is taken that voice inputting and voice outputting units are well known, and further, that it is well known to transfer voices from one location to another. (Telephones are the obvious example of apparatus for doing so, and telephones, of course, also include voice input and output units.) Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include voice input and output units, and to transfer voices to and from the center, for the obvious advantage of facilitating communications between a remote user and the center.

Claims 31 and 32 closely parallel claims 10 and 11, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

**Claims 33-37**

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), Bradley et al. (U.S. Patent 4,771,071), "MASTERCARD: Competing Banks Collaborate during First Implementation of SET Interoperability" (hereinafter "Competing Banks"), and official notice. Watanabe discloses an identification document transaction system comprising: a first center having a first database with data required for issuance of identification documents (Figure 2; column 12, lines 31-61). Watanabe does not disclose a second center for registering data for issuance of identification documents in a second database and also executing examination for issuance of passports, but Bradley et al. teach such a database (column 1, lines 60-66). Furthermore, the duplication of known parts for a multiple effect is held to be obvious to one of ordinary skill in the relevant art [*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F.2d 833 (7th Cir 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)], from which the use of two centers is held to be obvious. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include first and second centers with corresponding databases, for the obvious advantages of enabling the system to access data useful in determining whether to issue an identification document or not, and enabling the system to make records of identification document issuance data, so it will be possible to know how many identification documents have been issued, to whom they have been issued, and to obtain information about the persons to who they have been issued.

Watanabe discloses at least one passport transaction apparatus connected via a communication line to a center for processing identification document transactions by communicating with the center, wherein said identification document transaction apparatus comprises a communication unit for communicating with said center (column 12, lines 31-33); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe discloses transmitting an image of the identification document applicant to where this image is useful (column 15, lines 1-31). Watanabe does not expressly disclose the control unit making a determination whether the applied for identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4); also, Watanabe does disclose checking images against the applicant, implying that the applied for document is issued or not based on the image(s) (column 15, lines 25-31). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on at least the monitored image, for the obvious advantage of

issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to print the image, for the obvious advantage of producing a photographic identification document.

Watanabe discloses an issuing unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

Watanabe does not expressly disclose that the first center verifies the data inputted by the data input unit according to a request for verification of an applicant for an identification document from the identification document transaction apparatus to the first database by way of communication with the communication unit and returns a reply

according to a result of verification as to whether the applicant is the person he claims to be or not, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; note also elements 10 and in particular 3 in Figure 1). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the first center verify the data in such a manner, for the obvious advantage of determining whether an identification document applicant is the person he claims to be.

Watanabe does not disclose that a second center verifies the data inputted by the input center, etc., but, as stated above, in the first paragraph of this rejection, the duplication of known parts to obtain a multiple effect is held to be obvious to one of ordinary skill in the art.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the passport transaction apparatus is connected to a financial institution such as a bank or credit card company that executes an authorization of the passport applicant, so that the passport transaction apparatus identifies the applicant based on a result of the authentication, but it is standard



procedure to have purchasing apparatus connected to a financial apparatus, such as a credit card company, that executes an authentication of the applicant, so that the transaction apparatus identifies the applicant based on the result of the authentication, as taught by "Competing Banks" (see especially paragraph beginning "Mr. Roland Cheung"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard techniques to a passport transaction apparatus in particular, for the obvious advantage of determining or verifying a passport applicant's identity.

Watanabe does not disclose that the image input unit is [also] for monitoring the applicant, but official notice is taken that it is well known to use image input units (e.g., security cameras) to monitor people. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the image input unit also be used for monitoring passport applicants at a remote site, for such obvious advantages as assisting a passport applicant in applying for a passport correctly, and assuring that the passport applicant does not steal any valuables available at the remote site. Furthermore, the mere recitation of an intended use does not make known apparatus patentable.

Watanabe does not disclose that said first database is located at an institution other than said second center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the first database be located in an institution

other than said second center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control unit is configured to request certificate data stored in said first database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said residents database to be transmitted from said institution

and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

Claim 34 is closely parallel to claim 29, and is therefore rejected under 35 U.S.C. 103(a) on the same grounds.

Claim 35 is closely parallel to claim 30, and is therefore rejected under 35 U.S.C. 103(a) on the same grounds.

Claims 36 and 37 closely parallel claims 10 and 11, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

#### **Claim 38**

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), Nakamura et al. (U.S. Patent 4,068,213), and official notice. Watanabe discloses an identification document transaction apparatus that communicates with at least one host computer which handles issuance of identification documents, said apparatus comprising: a communication unit for communicating with an appropriate computer (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit that inputs data required in a procedure of the filing (column 15, lines 21-40).

Watanabe does not expressly disclose a display unit for displaying a guidance for filing an application for an identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subsequ.). Hence, it

would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the filing an application, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe does not expressly disclose a signature input unit for inputting a signature as data, but official notice is taken that it is well known to use signature input units for inputting a signature of as data. (For example, Examiner inputted his signature into such a unit to have a reproduction of his signature printed on his Virginia driver's license.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include such a signature input unit, for the obvious advantage of obtaining the identification document applicant's signature for the identification document and/or for issuer's records.

Watanabe does not expressly disclose a control section that controls the communication unit, the image input unit, the display unit, the data input unit, and the signature input unit, but it is held to be inherent that there must be circuitry and/or software to carry this out.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document

preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the data required in the procedure of the filing includes a PIN of an applicant for the passport, the control section communicates with a first host computer and a third host computer through the communication unit identifies the applicant based on a result of authentication by the PIN, and carries out a procedure for payment from an account specified by the PIN, but Nakamura teaches requiring a PIN of a purchaser, communicating with a computer so as to identify the purchase based on a result of authenticating the PIN, and so as to carry out a procedure for payment from an account specified by the PIN (column 1, line 65, through column 2, line 36; column 4, line 46, through column 5, line 5; column 5, line 57, through column 6, line 11). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard authentication and payment techniques to a passport transaction apparatus in particular, for the obvious advantages of verifying a passport applicant's identity and obtaining payment of passport application fees.

Watanabe does not disclose that said residents database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the residents database be located in an institution other than said center which executes the examination of issuance of

passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the

obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

**Claim 39**

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), Nakamura et al. (U.S. Patent 4,068,213), and official notice. Watanabe discloses an identification document transaction apparatus that communicates with at least one host computer which handles issuance of identification documents, said apparatus comprising: a communication unit that communicates with an appropriate computer (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit that inputs data required in a procedure of the filing (column 15, lines 21-40).

Watanabe does not expressly disclose a display unit for displaying a guidance for filing an application for an identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subsequ.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the filing an application, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe does not expressly disclose a signature input unit for inputting a signature as data, but official notice is taken that it is well known to use signature input units for inputting a signature of as data. (For example, Examiner inputted his signature

into such a unit to have a reproduction of his signature printed on his Virginia driver's license.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include such a signature input unit, for the obvious advantage of obtaining the identification document applicant's signature for the identification document and/or for issuer's records.

Watanabe does not expressly disclose a control section that controls the communication unit, the image input unit, the display unit, the data input unit, and the signature input unit, but it is held to be inherent that there must be circuitry and/or software to carry this out.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the data required in the procedure of the filing includes a PIN of an applicant for the passport, the control section communicates with a second host computer and a third host computer through the first computer, the control section transmits the PIN to the first host computer through the communication unit, identifies the applicant based on a result of authentication by the PIN, and carries out a procedure for payment from an account specified by the PIN, but Nakamura teaches



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requiring a PIN of a purchaser, communicating with a computer corresponding to the third host computer so as to identify the purchaser according to the PIN, and to carry out a procedure for payment from an account specified by the PIN (column 1, line 65, through column 2, line 36; column 4, line 46, through column 5, line 5; column 5, line 57, through column 6, line 11), while Sukegawa teaches communicating with a database corresponding to the second host computer through a control section (column 7, line 36, through column 8, line 26; see also Figures 1 and 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of patent applicant's invention to apply these standard authentication and payment techniques to a passport transaction apparatus in particular, for the obvious advantages of verifying a passport applicant's identity and obtaining payment of passport application fees.

Watanabe does not disclose that said residents database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the residents database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

**Claim 40**

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. (U.S. Patent 5,235,165), and official notice. Watanabe discloses an identification document transaction apparatus connected to a residents database storing therein identification data of the residents and also connected to a center which executes an examination for issuance of identification documents through a communication line, said apparatus comprising: a communication unit for communicating with said center (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit for inputting data for the application (column 15, lines 21-40).

Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

Watanabe does not expressly disclose a control section for transmitting the data inputted by each of the input units to the center using the communication unit, but it is held to be inherent that there must be circuitry and/or software to carry this out. Watanabe does not expressly disclose making the center determine whether the applied for identification document is to be issued or not based on the identification data

for the applicant which has been recorded in the resident database and in the transmitted data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4); also, Watanabe does disclose checking images against the applicant, implying that the applied for document is issued or not based on the image(s) (column 15, lines 25-31). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the monitored image and the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

Watanabe does not disclose that the applicant is monitored at a site remote from said image input unit, but official notice is taken that it is well known to use image input units (e.g., security cameras) to monitor people remotely. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the image input unit also be used for monitoring the passport applicant at a remote

site, for such obvious advantages as assisting the passport applicant in applying for a passport correctly, and assuring that the passport applicant does not steal any valuables available at the remote site. Furthermore, the mere recitation of an intended use does not make known apparatus patentable.

Watanabe does not disclose that said residents database is located at an institution other than said center which executes the examination of issuance of passports, but official notice is taken that it is well known for databases to be remote from their users. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the residents database be located in an institution other than said center which executes the examination of issuance of passports, for the obvious advantage of benefiting from information accumulated elsewhere than at the State Department, or whatever other center executes the examination of issuance of passports.

Watanabe does not disclose that one of reissuing and newly issuing of the passport is selectable, but official notice is taken that it is well known for passport applicants to be called on to select whether they are seeking renewed or newly issued passports (and Examiner recalls being asked a parallel question when obtaining a driver's license). Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have one of reissuing and newly issuing of the passport be selectable, for the obvious advantage of both reissuing passports and issuing new passports, and following appropriate corresponding procedures, such as

checking data already on file for existing passport holders, or re-using passport serial numbers, as opposed to generating new ones.

Watanabe does not expressly disclose that the control section is configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, but official notice is taken that it is well known to request data stored in databases (the World Wide Web is an obvious example), and make use of such data in making decisions. Hence, it would have been obvious to one of ordinary skill in the art at the time of patent applicant's invention to have the control section be configured to request certificate data stored in said residents database to be transmitted from said institution and to use the certificate data transmitted in reissuing or issuing the passport, for the obvious advantage of establishing whether or not a passport applicant was the person he claimed to be, and otherwise eligible for a passport.

### ***Response to Arguments***

Applicant's arguments filed August 10, 2004 have been fully considered but they are not persuasive. Applicant argues that each of claims 1, 2, 3, 14, 26, 27, 28, 33, and 40 has been amended to clarify that the issuing of the passport is dependent on the remote monitoring of the applicant at the passport center, such that the passport application will be denied based on the monitored image of the applicant. Applicant argues that none of the applied references disclose this feature. Examiner replies that in claim 15, Watanabe discloses taking images of identification document applicants,

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and then writes, "The face images and be retrieved [*sic* – this is presumed to be error for "can be retrieved"] using the retrieval terminal unit **39** and checked against the applicant, when reissuing of the driver's license is requested." Checking images implies that a driver's license (or passport) can be denied if the image does not correspond to the document applicant, or there are other problems, and Examiner is not persuaded that calling the image a monitored image makes it patentably distinct from the prior art of record, particularly Watanabe.

Next, Applicant argues with respect to independent claims 38 and 39, Applicant argues that the applied references fail to disclose or fairly suggest the specific structure for authenticating the PIN as now called for in claims 38 and 39. While no one of the applied references specifically discloses that precise structure, the combination of references is believed to make all recited features obvious. No feature is believed to be novel, and nothing in the combination is held to be nonobvious. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The multiple host computers are taught by the prior art, and the use of PIN numbers to authenticate persons wishing to charge payments to their accounts is taught by the prior art (Nakamura in particular); therefore the particulars of the PIN data being transmitted between computers to carry out a procedure for identifying a passport applicant and

authorizing payment from the passport applicant's account for (presumably) a passport application fee are held to be obvious.

Applicant further argues that each of the independent claims has been amended to include the features that the residents/first database is located in an institution other than the center which executes the examination of issuance of passport; that one of reissuing and newly issuing of the passport is selectable; and that the control section/unit is configured to request certificate data stored in the residents/first database to be transmitted from the institution and to use the certificate data transmitted in reissuing or issuing the passport. However, Examiner does not believe that any of these limitations is nonobvious, and has given reasons in the rejections set forth above. It is well known to access remote databases in this age of the Internet, and has long been well known to select whether one is applying for a reissued or newly issued identification document (Examiner recalls a state trooper asking about that when he applied for a Pennsylvania driver's license in 1987). Accessing remote databases implies control means of some sort configured to request data from the remote databases.

For these reasons, the claims are held to be unpatentable.

#### ***Regarding the Taking of Official Notice***

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.



**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The anonymous article, "Polaroid Demonstrates Digital ID System with Electronic Portrait and Signature Storage for Drivers Licenses, Security Passes," discloses a system for issuing drivers' licenses and other photo IDs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

October 28, 2004